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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,754	02/08/2002	Chris R. Snider	DP-305026	9283

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EXAMINER

COURSON, TANIA C

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/068,754

Applicant(s)

SNIDER, CHRIS R.

Examiner

Tania C. Courson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. An indicator feature (i.e. halo section illuminates) is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The light source is still not positively claimed.

Claims 2-5, 7 and 9-11,13 are rejected due to their dependency on claims 1 and 8, respectively.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 7, 8 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang (US 4,549,050) in view of Furey (US 3,074,372).

Lang discloses in Figures 1-2, an illuminated knob comprising:

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With respect to claims 1, 7, 8, and 13:

- a) a translucent base (Fig. 2, light transmitting plastic 28) including an outer surface having an upper portion and a lower portion (Fig. 2), said base defining a translucent halo section located on said lower portion of said outer surface (Fig. 2 and column 4, lines 14-18), and an opaque over mold (Fig. 2, shield covering means on light transmitting plastic 28) covering a portion of said outer surface/upper and lower portions not including said halo section (Fig. 2 and column 4, lines 14-18);
- b) a mounting panel (Fig. 1, panel 12), said lower portion/halo section of said base positioned adjacent said panel (Fig. 2) and wherein said halo section emits light from the light source and illuminates at least a portion of said mounting panel (Fig. 2 and column 4, lines 14-18).

Lang does not disclose an appliqué element mounted on a translucent base, wherein said appliqué element extends to cover a halo section.

With respect to the preamble of the claims 1 and 8: the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

With respect to an appliqué element mounted on a translucent base, wherein said appliqué element extends to cover a halo section, Furey teaches an illuminated indicator that consists of an appliqué element (Fig. 4, colored segments 52, 54, 56) mounted on a translucent base (Fig. 4, transparent drum 50), wherein said appliqué element extends to cover a halo section (Fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the illuminated knob of Lang, so as to include an appliqué element, as taught by Furey, so as to provide a greater enhancement in visibility via the contrasting colors during use of the knob.

With respect to the term “ adapted to ” in claim 13: Lang discloses a mounting panel which is considered to be “ adapted to ” be mounted in front of the light source as stated in the claim. Furthermore, the term “ adapted to ” makes what follows a functional statement and not a positive limitation because it has been held that the recitation that an element is “ adapted to ” perform a function only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

With respect to method claims 14-16: The method steps claimed will be met during the normal operation of the apparatus stated above.

5. Claims 3-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang and Furey in view of Prior Art (specification, page 5, lines 1-3).

Lang and Furey disclose an illuminated display, as stated above in paragraph 4.

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Lang and Furey do not disclose the opaque over mold including a soft touch surface, and the appliqué element including a daytime and a lowlight screening.

The use of a soft touch surface instead of the coating surface material disclosed by Lang and Furey to make the opaque over mold, absent any criticality, is only considered to be the use of a “preferred” or “optimum” type of coating material that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

The Prior Art teaches the appliqué element that consists of a daytime and a lowlight screening (specification, page 5, lines 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the illuminating display of Lang and Furey, so as to include a daytime and a lowlight screening, as taught by the Prior Art, so as to provide a commonly used appliqué materials such as those providing daytime and low light colorations, as disclosed by the Applicant.

Response to Arguments

6. Applicant's arguments filed on September 15, 2003, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose illuminating devices:
Gliencke (US 6,224,221 B1)
Wright et al. (US 4,131,033)
Gaguski (US 2,699,141)

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (703) 305-3031.

The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
December 4, 2003